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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,378	02/06/2004	Joseph D. Masci	0114855-008	6343
29159	7590	10/09/2009		
K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690			EXAMINER HENRY, THOMAS HAYNES	
			ART UNIT	PAPER NUMBER
			3714	
			NOTIFICATION DATE	DELIVERY MODE
			10/09/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

### Office Action Summary

**Application No.**

10/773,378

**Applicant(s)**

MASCI ET AL.

**Examiner**

THOMAS H. HENRY

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-66 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For the sake of brevity, the deficiencies of claim 1 will be discussed, however it should be understood that the same deficiencies are also found in other independent claims and inherited by claims dependent therefrom. The claims require the "predetermined modifier being independent of said winning symbol combination," however there is no support in the instant specification that explicitly states that the predetermined modifiers are independent of the winning symbol combinations.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

Art Unit: 3714

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (US 6190255 B1) in view of Barrie (US 5833537).

Regarding claims 1, 12, 13, 24, 25, 34, 38, 47 and 51-56 Thomas discloses a gaming device comprising:

A plurality of reels controlled by a processor and each reel including a plurality of symbols (figure 2, 12 and 13 and the detailed description thereof);

A plurality of different paylines associated with the reels, the plurality of paylines include a first payline (figure 1 and 3);

A plurality of different predetermined modifiers including a first predetermined modifier, each of said different predetermined modifiers associated with a different one of said paylines (figure 3, feature depicted by the row of 7 jackpot, each payline is inherently associated with a multiplier. Payline 1 is the 1 multiplier, payline 2 is the 2 multiplier, 3 is the 3 multiplier and so on). Wherein the first predetermined modifier is associated with the first payline for each play of the game (the modifiers are set on a paytable that does not change after each game, however it should be noted that paylines and payout amounts could be changed by casino establishments to suit their various needs);

A plurality of different winning combinations of symbols adapted to occur on said paylines (figure 3); and

Wherein at least one processor is programmed for a play of the game to: activate the reels, determine an outcome and provide at least one outcome adapted to be provided to the player when the winning symbol

Art Unit: 3714

combination occurs on one of the paylines, wherein the outcome is based on an award associated with said winning symbol combination and the predetermined modifier associated with the payline on which said winning combination occurred.

Thomas discloses providing different payouts based on the occurrence of the winning combination (jackpot 7). If the winning combination occurs on a high labeled payline, the pay out is greater and therefore inherently there is some multiplier associated with the payout.

Regarding claims 51-55, wherein the modifiers are based on the number of the respective payline (figure 3).

Regarding claim 2 and 14, the payline includes horizontal and diagonal paylines (figure 1).

Regarding claim 3, 15 and 26, wherein each of the paylines are numbered successively (figure 1 and 3).

Regarding claim 4, 16 and 27, wherein the value of the modifiers increase by a predetermine amount for each of the successively numbered paylines (figure 3).

Regarding claim 5, 17 and 28, wherein the value of the modifiers increase sequentially for each of the successively numbered paylines (figure 3).

Regarding claim 6 and 18, wherein the value of the modifiers increase by a predetermined factor for each of the successively numbered paylines (Figure 3).

Regarding claim 7 and 19, wherein the number of the paylines is predetermined (figure 1 and 3).

Regarding claim 8 and 20, the player places wager amounts for each of the paylines in a successive order (figure 1).

Regarding claim 9 and 21, wherein the outcome includes any awards associated with winning symbol combination occurring on the paylines modified by the modifiers respectively associated with said paylines and multiplied by the wager amount inputted by the player for said respective paylines. The game of Thomas is depicted as a 25 cent machine so inherently the wager is multiplied by 400 times and further multiplied by the base of a 1 multiplier for the case of payline 1 in figure 3 for a 7 jackpot. It is multiplied by 400 for the base wager and then 2 for the payline 2 and so on for successive paylines.

Regarding claim 10, 11, 22 and 23, the players wager the same input amount for each payline since the machine of Thomas is depicted as a 25 cent machine and so each payline is wagered at 25 cents (figure 1).

Regarding claim 12 and 24, see rejection of claim 1. It should be noted that the claims do not require all winning outcomes, but merely "a" or "at least one" and so the a or at least one is the Jackpot 7 of Thomas.

Regarding claims 28-34, see discussion of claims 2-10 respectively.

Regarding claims 37 and 50, the game operators on memory (figure 14 feature 64).

Regarding claims 39-47, see discussion of claims 2-10 respectively.

Regarding claims 1, 13, 25, 38, 51, 52, 55 and 56, Thomas fails to teach the amended limitations of providing players with predetermined modifiers associated with wagered-on paylines wherein the outcome is based on said

Art Unit: 3714

predetermined modifier. In a related patent, Barrie also teaches methods and apparatus drawn towards casino slot machines. Barrie more specifically teaches the use of predetermined modifiers associated with paylines in the form of payline multipliers shown in figure 4 and the detailed description thereof. These payline multipliers merely multiply the result of the associated symbol combination and can therefore be said to be independent of the symbol combination.

Regarding claims 57 and 58, the prior art fails to teach the limitations of the gaming device operating on a network and the network being the internet. However, as previous stated in the rejections of claims 35, 36, 48, 53 and 54 (incorporated herein), operation of gaming devices such as the one taught by Thomas through an internet network is notoriously old and well known in the art. One would be motivated to do so because operation of the game on a network allows for operators to monitor the activity of the game. Therefore it would be been obvious to one of ordinary skill in the art at the time of invention to operate the game of Thomas on a network.

5. In re claims 1, 13, 25, 38, 51, 52, 55, 56, and 59-66 Thomas teaches the multiplier being the same for each play of the game.

#### ***Response to Arguments***

6. Applicant's arguments filed 10/14/08 have been fully considered but they are not persuasive.

7. Applicant argues that the subject matter of "the predetermined modifier being independent of the winning symbol combination" has support in the

Art Unit: 3714

specification with the disclosure "each of the paylines includes a fixed modifier, such as a fixed multiplier, which multiplies any award associated with winning symbol combinations" (abstract). However this does not disclose complete independence between the multiplier and the winning paylines. As this is essentially a negative limitation (claiming no correlation between the multiplier and the winning paylines), the specification disclosing one way in which the two are not correlated is not enough to say that there is no correlation whatsoever.

8. Applicant argues that Barrie is does not disclose a predetermined modifier; however the modifiers are predetermined, even if they can be changed. Furthermore, Thomas discloses keeping a constant predetermined modifier from game to game.

9. All official notice from previous office actions have not been traversed, thus the official notice is taken as applicant admitted prior art (MPEP 2144.03 (c))

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

Art Unit: 3714

the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS H. HENRY whose telephone number is (571)270-3905. The examiner can normally be reached on M-F 9 AM - 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/  
Supervisory Patent Examiner, Art Unit 3714

Thomas H Henry  
Examiner  
Art Unit 3714